



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/046,670

01/16/2002

Michael Raley

111325-000200

2328

22204

7590

05/28/2008

NIXON PEABODY, LLP

401 9TH STREET, NW

SUITE 900

WASHINGTON, DC 20004-2128

EXAMINER

DADA, BEEMNET W

ART UNIT

PAPER NUMBER

2135

MAIL DATE

DELIVERY MODE

05/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/046,670	Applicant(s) RALEY ET AL.	
	Examiner BEEMNET W. DADA	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23,26-34,36-59,62-70 and 72-79 is/are rejected.
- 7) ☒ Claim(s) 24,25,35,60,61 and 71 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/20/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in reply to an amendment filed on March 17, 2008. Claims 1, 28 and 37 have been amended and new claims 76-79 have been added. Claims 1-79 are pending.

Response to Arguments

Applicant's arguments filed March 17, 2008 have been fully considered but they are not persuasive. Applicant argues that, the art on record fails to teach, the claim limitation, 'the security module intercepts a request to the rendering engine to render the digital content, determines whether the requested digital content is protected content, and grants or denies the request to render the digital content based on the usage rights associated with the digital content only if it is determined by the security module that the requested digital content is protected content.' Examiner disagrees.

Examiner would point out that, Peinado teaches a system determining if a request for digital content is for protected digital content and granting or denying access to the content based on usage rights associated with the content only if it is determined by the security module that the requested digital content is protected content [figure 5B, steps 503-507, 517, column 14, line 66-column 15, line 19]. Furthermore, Rabin teaches a system for protecting information, including a security module that intercepts requests to a rendering engine that would enact a violation of usage rights associated with the content [see Rabin, column 11, lines 9-34 and column 24, lines 33-48], and thus grant or denies the request to access the content based on the usage rights associated with the content (i.e., determining the use policy of a tag associated with the instance software, and determining if the request is valid by examining the tag/tag table (usage supervision/rights) and allowing/denying access, see figure 8, steps 275, 276, column 18, lines 10-29), which is equivalent to the claimed steps of the security module intercepts a request to the rendering engine to render the digital content, determines whether the requested digital content is protected content, and grants or denies the request to render the digital content based on the usage rights associated with the digital content only if it is determined

Art Unit: 2135

by the security module that the requested digital content is protected content. Examiner would further point out that, the art on record teaches the claim limitations and therefore the rejection is respectfully maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 77 and 79 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to mention or teach the system, method wherein, the security module is installed on the client computer at a different time than the standard application program.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23, 26-34, 36-59, 62-70, 72 and 76-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peinado et al. US Patent 6,816,596 (hereinafter Peinado) in view of Rabin et al. US 6,697,948 B1 (hereinafter Rabin).

As per claim 1, Peinado teaches a system for distributing digital documents having usage rights associated therewith, said system comprising:

a server having at least one digital document stored thereon [column 2, lines 60-67]

a client computer having a standard application program including a rendering engine capable of being accessed to render content [column 3, lines 5-13, figure 4, units 34 and column 15, lines 6-10];

a communications network coupled to said client and said server [column 2, lines 61-67]; and

a client side security module, separate from the rendering engine, which is downloaded and included in said client computer, the security module being adapted to be attached to the standard application program for enforcing security conditions for accessing the rendering engine [column 3, lines 33-67, figure 4, DRM system 32, Black Box 30 and column 13, lines 20-31].

Peinado further teaches the system determining if a request for digital content is for protected content and granting or denying access to the content based on usage rights associated with the content only if it is determined by the security module that the requested digital content is protected content [figure 5B, steps 503-507, 517, column 14, line 66-column 15, line 19].

Peinado is silent on the system, wherein the security module intercepts requests to the rendering engine. However, within the same field of endeavor, Rabin teaches a system for protecting information, including a security module that intercepts requests to a rendering engine to render the digital content that would enact a violation of usage rights associated with the content [see Rabin, column 11, lines 9-34 and column 24, lines 33-48], and thus grant or denies the request to access the content based on the usage rights associated with the content (i.e., determining the use policy of a tag associated with the instance software, and determining if the request is valid by examining the tag/tag table (usage supervision/rights) and allowing/denying access, see figure 8, steps 275, 276, column 18, lines 10-29). It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to employ the teachings of Rabin within the system of Peinado in order to further enhance security of the system.

As per claims 2 and 3, Peinado further teaches the system wherein the security conditions include usage rights associated with the content [column 3, lines 45-56].

As per claims 4, 23 and 36, Peinado further teaches wherein said security module is operative to determine if said client computer is missing any security component software based on a predetermined configuration required for managing security of requested content and if said at least one client unit is missing any security component software based on said predetermined configuration, said security module is operative to provide said missing security component software to said client computer [column 15, lines 25-50].

As per claims 5, Peinado further teaches the system wherein if said security module determines that the request is not for protected content, the security module deactivates [column 35 line 66 – column 36 line 18].

As per claim 6, Peinado further teaches the system wherein said server comprises plural server computers and said security module is operative to cause said client computer to exchange one or more keys with a first of said server computers to obtain a validation certificate, said validation certificate permitting said client computer to securely communicate with a second of said server computers without any further exchange of keys between said client computer and any of said server computers [column 3, lines 5-23].

As per claims 7 and 8, Peinado teaches the system wherein said security module is operative to define a user interface of said standard application in accordance with parameters specified by said server [column 14, lines 16-34].

As per claims 9-11, Peinado teaches the system wherein said security module is operative to superimpose a watermark based on client specific data on a image rendered by said rendering engine [column 8, lines 3-13].

As per claims 12-17, 26-27, 32-34 Peinado teaches the system further comprising a transaction aggregator system for managing transactions relating to document distribution and a server side security component that directs the client computer to the transaction aggregator to receive a client side security

component in exchange for transmitting user information to the transaction aggregator when said client computer makes a request for content and when said client side security component is not installed in said client computer, and wherein said transaction aggregator validates said client computer, based on predetermined conditions, and wherein said client side security component is unique to thereby identify said client computer to said server and to permit said server to report information relating to transactions with said client side computer to said transaction aggregator [column 15, line 58 – column 16, line 15].

As per claim 18-19, Peinado teaches the system wherein said server comprises a storage device containing a folder of embedded links to digital content and wherein the address of said folder is selected one of and to be difficult to ascertain, said security module being operative to provide information relating to at least one of the links when said client computer sends a request for content to said server and said security module indicates that that said client computer is authorized to access the content [column 2, line 64 – column 3, line 13].

As per claims 20-22, Peinado further teaches the system wherein said security module creates a document containing references to the digital content and spawns a child instance of the rendering engine to render the document, and wherein said child instance of said rendering engine is operative to follow the references to retrieve content through an asynchronous protocol from a secured location [column 13, line 59 – column 14, line 16].

As per claims 28 and 29, Peinado further teaches the system wherein said security component embeds all security information in a header of a document transmitted between said client computer and said server, said document having a body that does not contain security information for content in the document [column 19, lines 47-60].

As per claim 30 and 31, Peinddo further teaches the system wherein said security module is operative to check a request made by said client computer at two stages, a first stage filter checks if said request corresponds to a prohibited URL and a second stage filter checks if said request corresponds to a prohibited

directory, and wherein if said request corresponds to a prohibited URL, or if said request corresponds to a prohibited directory, then said request is denied by said server [column 17, lines 12-37].

As per claims 76, Peinado further teaches the system wherein the security module is installed on the client computer separately from the standard application program [column 3, lines 33-67].

As per claims 77, Peinado further teaches the system wherein the security module is installed on the client computer at a different time than the standard application program [column 3, lines 33-67].

As per claims 37-59, 62-70, 72, 78 and 79, the claimed steps correspond to the functions of the elements of the system claims 1-36, 76 and 77 which has been rejected above and thus rejected with the same reason.

Claims 73-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peinado et al. US Patent 6,816,596 (hereinafter Peinado) in view of Rabin et al. US 6,697,948 B1 (hereinafter Rabin) and further in view of Luckenbaugh et al. US 6,311,269 B2 (hereinafter Luckenbaugh).

As per claims 73-75, the combination of Peinado and Rabin teaches the claim limitations as indicated above. Peinado and Rabin teach delivering content, intercepting a security information and honoring usage rights while processing the content as indicated above. Peinado-Rabin is silent on the system wherein an HTML header and body, including security information embedded as recited in claims 73-75. However, within the same field of endeavor, Luckenbaugh teaches an HTML document adapted to be rendered by Web browser in a secure environment (figure 2B), said document comprising: an HTML header defined between header tags (figure 2B, step 233); an HTML body containing content (figure 2B, step 234); and security information (i.e., Cookie) embedded in said header, said security information being associated with one or more usage rights [figure 2B, step 233 and column 8, line 53 – column 9, line 16]. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to employ the teachings of Luckenbaugh within the combination of Peinado and Rabin in order to render content in an HTML based environment and provide efficient access to content.

Allowable Subject Matter

Claims 24, 25, 35, 60, 61 and 71 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BEEMNET W. DADA whose telephone number is (571)272-3847. The examiner can normally be reached on Monday - Friday (9:00 am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2135

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Beemnet W Dada/

May 19, 2008

/KIMYEN VU/

Supervisory Patent Examiner, Art Unit 2135